

REMARKS/ARGUMENTS

Claims 1-2, 4-5 and 7-21 are currently pending in this application. Claim 18 is cancelled without prejudice or disclaimer. Claim 3 was previously cancelled. No new matter has been added. Reconsideration of the present application is requested in view of the following remarks.

As an initial matter, Applicant wishes to thank the Examiner for the indicated withdrawal of several rejections of record.

Applicant also formally requests, in view of the pending and maintained rejections, an interview with the Examiner to further resolve the rejections and expedite allowance of the present claims.

Claim Objection

Claim 18 is objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. In response, Applicants have cancelled claim 18, as indicated above. Accordingly, withdrawal of the objection is requested.

Rejection under 35 U.S.C. § 112, first paragraph

The rejection of claims 1-2, 4-5 and 7-21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is respectfully traversed.

In summary, at pages 2- 4, paragraphs 5-8 of the Office Action, the Examiner alleges that the process steps disclosed in the examples are very specific, and thus too generic for the process recited in the present claims.

Regarding claim 1, the Examiner alleges that there is no support for a process for a generic composition comprising polymerized polycaprolactam and titanium dioxide. In other words, the Examiner asserts that the claims recite a genus, while the examples only support a species of that genus. (See also pages 14-15, paragraph 20 of the Office Action).

Regarding claim 17, the Examiner alleges that while the specification describes a particular, embodiment comprising specific titanium dioxide and dispersing agents, in specific amounts, there is no support in the specification for the 0.2 wt.% of a generic dispersing agent, as recited in claim 17.

In response, Applicant asserts that the specification provides support for the genus, in which examples are not necessary or even required under current U.S. patent practice.

Moreover, Applicant points out that according to MPEP § 2163 ("Written Description" Requirements), for each claim drawn to a *genus*:

The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus.

(Emphasis added).

Since the specification more than sufficiently shows that the inventors were in possession of the claimed invention, in light of the examples and a representative of a number of species of the components of the present claims, Applicants assert that the rejection has been improperly maintained. Applicant also notes, as indicated above, that claim 18 has been cancelled.

Accordingly, withdrawal and reconsideration of the rejections are requested.

Rejection under 35 U.S.C. § 102(b)

The rejection of claim 20 under 35 U.S.C. § 102(b) as anticipated by Strehler et al. (US Patent No. 4,388,425) is respectfully traversed for the reasons discussed below.

Regarding anticipation, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Id.* (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). (Emphasis added).

Applicants note, regarding the elements of claim 20, the Office has not addressed the average mean pressure build-up of the polymerized product specifically recited in claim 20, or pointed out each of the required process steps of claim 1 in this rejection. The Office only alleges, in summary, that the reference describes a mixture of water, polymerized caprolactum, and titanium dioxide, while apparently overlooking the nature of the process. (See page 6, continuation of paragraph 12 on page 5). Further, in view of the previous obviousness rejections using this reference, the Office has basically acknowledged that the reference (alone) is deficient.

Therefore, the rejection should be withdrawn.

Rejections under 35 U.S.C. § 103(a)

The rejections of claims 1, 4 and 7 under 35 U.S.C. § 103(a) as obvious over Wehr (US Patent No. 4,879,120) and Seeger (US Patent No. 5,540,499); claims 2 and 8-9 as obvious over Wehr and Seeger and in view of Strehler et al. (US Patent No. 4,388,425); and claim 12 as obvious over Wehr and Seeger and in view of Belde et al. (US Patent No. 4,474,681) are traversed for reasons of record and the reasons discussed below.

According to the Office, these rejections were sufficiently set forth in the Office Action dated March 3, 2009. The Office acknowledges that Wehr and Seeger are deficient on pages 9-13 of the Office Action, but that asserts the claimed ranges/concentrations would still be obvious.

On pages 15-16 of the Office Action, the Office alleges that there would have been a reasonable expectation of success in modifying Wehr to include the mixing apparatus of Seeger. However, Applicants point out, that even assuming that the combination could be possible, the combination still does not provide the claimed average mean pressure build-up of the polymerized product. Moreover, regarding Strehler et al., the examples in the present specification provide improved results over the reference, in view of a comparison to a titania-containing polyamide sample prepared according EP 070452 (in which Strehler is a counterpart).

The rejections of claims 5, 8-11, 13-18 and 21 under 35 U.S.C. § 103(a) as obvious over Wehr and Seeger and in view of Strehler et al., and claim 19 as obvious over Wehr, Seeger and Strehler et al., and in view of Lewis (Hawley's Condensed Chemical Dictionary) are also respectfully traversed. Applicants point out, inter alia, that Strehler et al. is clearly deficient and should not be applied in view of the above-discussed direct comparison. Further, in view of the above discussed written description support for the pressure build-up feature (as supported by the genus provision in the MPEP), Applicants point out that Examiner must give patentable weight to the feature and consider the comparative difference.

CONCLUSION

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Applicant believes no additional fee is due with this response. However, if an additional fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00082-US from which the undersigned is authorized to draw.

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Respectfully submitted,

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